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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,500	11/29/2000	David A Cheresh	TSRI 651.1	5356

2387 7590 07/14/2004

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EXAMINER

SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/701,500

Applicant(s)

CHERESH ET AL.

Examiner

Richard Schnizer, Ph. D

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.


Claim(s) rejected: 1, 4, 14-16, 33, 34.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: New limitations requiring that a particular amount of Src protein must be delivered per unit mass of the composition have not yet been considered and would require new search and consideration..

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the Office Action characterizes the claimed material as a composition when it is actually an article of manufacture comprising a packaging material. Applicant's attention is directed to page 317, column 2, item 2.3 of Kato which teaches that the nucleic acid was contained in an electroporation device, which can be considered an article of manufacture. Furthermore, it is well known to those of ordinary skill in the art that the cloning steps described in item 2.3 are carried out in containers such as microfuge tubes or microtiter plates that are considered to be articles of manufacture, so Kato clearly teaches an article of manufacture comprising a nucleic acid encoding Src. With regard to the printed matter, it is clear that printed matter cannot change the function of the nucleic acid, and that the function of the nucleic acid is inherent. MPEP 2112.01(see latest version at <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>) indicates that wherein the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed material from the prior art. In this case, the printed matter does not alter the function of the product, it merely suggests a use that is not contemplated in the cited prior art. Even if one assumes that this suggested use is novel it does not render the claimed product patentable because something which is old does not become patentable upon discovery of a new property. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Applicant's arguments regarding Miller are unpersuasive because in Miller the printed matter was physically part of the composition, and without that printed matter the composition could not be readily used for the intended purpose. Therefore the printed matter changed the functionality of the composition. Similar reasoning applies to Gulack. The printed matter changed the physical nature and functionality of the hat of Gulack. In the instant case, the printed matter is separate from the nucleic acid, and in no way changes its inherent function of expressing Src, so the situations are not analogous. .


DAVE T. NGUYEN
PRIMARY EXAMINER